

Appl. No.: 10/528,528
Amdt. dated March 3, 2008
Reply to Office Action of December 6, 2007

REMARKS

Applicant acknowledges with appreciation the thorough examination of the present application as evidenced by the first Official Action. Claims 1-23 are pending in this application. Of these, the Official Action objects to Claims 1-4, 5-9, and 10-14 for various informalities. The claims have been amended to correct the various informalities. Notably, independent Claims 1, 5 and 10 have been amended to clarify that the network is wired, wireless, or both. Claims 3 and 4 have been amended to recite “a message” instead of “the message” to provide sufficient antecedent basis. Claim 1 has been further amended to recite “accessed by” instead of “accessed to.” Claim 1 has also been amended to recite “with the purchase” and “of the electronic gift certificates” instead of “on the purchase” and “on the electronic gift certificates”, respectively. No new matter has been added by these amendments. Therefore, Applicant respectfully submits that the objection to the claims is overcome.

The Official Action rejects Claim 7 under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the enablement requirement. In this regard, the Official Action alleges that it is not clear how Claim 7 can recite “a number of sheets” when it depends from Claim 5 which recites an electronic gift certificate. Claim 7 has been amended to remove the recitation of “a number of sheets”. Accordingly, Applicant respectfully submits that the rejection of Claim 7 under 35 U.S.C. § 112, first paragraph, is moot.

The Official Action rejects Claims 4-9 and 15-23 under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite. More particularly, with respect to Claim 4, the Official Action alleges that the recitation of Claim 4 does not clarify whether a user is purchasing a gift certificate or making a purchase with the gift certificate. Claim 4 recites “receiving the user's usage request” and “inquiring the gift certificate database of an existence state of the gift certificate possessed by the user.” See, for example, paragraphs [0061] - [0064] of the specification. In this regard, a usage request implies a request to use the gift certificate to make a purchase, and not to purchase one. Moreover, Claim 4 recites that the gift certification is in the

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user's possession. Accordingly, Applicant respectfully submits that Claim 4 is clear in that the user is attempting to use the gift certificate to make a purchase instead of buying a gift certificate. The Official Action further alleges that the recitation of means of allowing the usage to process the settlement is unclear. In this regard, Claim 4 has been amended to recite a means for allowing processing of the settlement on the price information when the settlement is possible based on the usage of the gift certificate. In other words, when the settlement of the price information is possible, the settlement process is effectuated based on the usage of the gift certificate. Moreover, Claim 4 has been amended for clarification to recite "a user". No new matter has been added by way of these amendments. Accordingly, Applicant respectfully submits that the rejection of Claim 4 is overcome.

With respect to the rejection of Claim 5, the Official Action alleges that Claim 5 is indefinite because of the recitation of "electronic gift certificate bought by the user" when the claim is directed to buying an electronic gift certificate. In this regard, Claim 5 has been amended to remove any recitation of "bought by the user". Accordingly, Applicant respectfully submits that the rejection of Claim 5 is moot.

With respect to the rejection of Claims 9 and 17 the Official Action alleges that Claims 9 and 17 are indefinite because of the recitation relating to the message format sent to the user. In this regard, Claims 9 and 17 have been amended to recite that the message sent to the user can be in either SMS or MMS formats. Additionally, Claim 14 has been similarly amended. No new matter has been added by way of these amendments. Accordingly, Applicant respectfully submits that the rejection of Claims 9 and 17 is overcome.

With respect to the rejection of Claims 15-23, the Official Action alleges that the recitation of Claim 15 does not clarify whether a user is purchasing a gift certificate or making a purchase with the gift certificate. Initially, Applicant notes that the preamble of Claim 15 recites "a gift certificate service system including a gift certificate database and a gift certificate service server to manage usage of the electronic gift certificates". Accordingly, Claim 15 relates to

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managing the usage of gift certificates, or, in other words, the management of gift certificates in the purchasing of a product or service. Claim 15 further recites “receiving the user's usage request” and “inquiring the gift certificate database of an existence state of the gift certificate possessed by the user.” See, for example, paragraphs [0061] - [0064] of the specification. In this regard, a usage request implies a request to use a gift certificate, not to purchase one. Moreover, Claim 15 recites that the gift certification is in the user's possession. Accordingly, Applicant respectfully submits Claim 15 is clear in that the user is attempting to use the gift certificate to make a purchase. In this regard, and relating to Claim 16, in the event the system determines that the gift certificate is not in existence, such as, for example, the user has in possession an invalid gift certificate, a gift certificate buying process will be performed as recited in Claim 16. The Official Action further alleges that the recitation of allowing the usage to process the settlement is unclear. In this regard, Claim 15 has been amended to recite a means for allowing processing of the settlement on the price information when the settlement is possible based on the usage of the gift certificate. In other words, when the settlement of the price information is possible, the settlement process is based on the usage of the gift certificate. No new matter has been added by way of these amendments. Accordingly, Applicant respectfully submits that the rejection of Claim 15 is overcome.

With respect to the rejection of Claim 23, the Official Action alleges that Claim 23 is indefinite for reciting that an online shop includes an online shopping mall. In this regard, Claim 23 has been amended to recite an online shopping mall that includes at least one online shop. No new matter has been added by way of these amendments. Accordingly, Applicant respectfully submits that the rejection of Claim 23 is overcome.

Therefore, Applicant respectfully submits that the rejection of Claims 4-9 and 15-23 under 35 U.S.C. § 112, second paragraph, is overcome.

The Official Action rejects Claims 1-5, 8-10, 12-15, 17, 18 and 23 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No 6,370,514 to Messner (hereinafter the

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“Messner ‘514 patent”) in view of Official Notice. The Official Action further rejects Claims 6 and 11 under 35 U.S.C. § 103(a) as being unpatentable over the Messner ‘514 patent and Official Notice, and further in view of U.S. Patent Application Publication No. 2002/0087469 to Ganesan et al. (hereinafter the “Ganesan ‘469 publication”). The Official Action rejects Claim 7 under 35 U.S.C. § 103(a) as being unpatentable over the Messner ‘514 patent and Official Notice, and further in view of U.S. Patent No. 7,209,889 to Whitfield (hereinafter the “Whitfield ‘889 patent”) and U.S. Patent Application Publication No. 2002/0032650 to Lee (hereinafter the “Lee ‘650 publication”). The Official Action also rejects Claim 16 under 35 U.S.C. § 103(a) as being unpatentable over the Messner ‘514 patent and Official Notice, and further in view of the Ganesan ‘469 publication and the article “Ecount Introduces Incentives Program” (hereinafter “Ecount”). The Official Action rejects Claims 19 under 35 U.S.C. § 103(a) as being unpatentable over the Messner ‘514 patent and Official Notice, and further in view of U.S. Patent Application Publication No. 2003/0004812 to Kasasaku (hereinafter the “Kasasaku ‘812 patent”). Finally, the Official Action rejects Claims 20-22 under 35 U.S.C. § 103(a) as being unpatentable over the Messner ‘514 patent in view of Official Notice and in further view of the Whitfield ‘889 patent.

Independent claims 1, 5, 10, and 15 are directed to a system and methods for managing sales, gifting, and usage of electronic gift certificates according to requests by a communication terminal through a network. More particularly, independent Claim 1 is directed to a gift certificate service system for managing sales, gifting, and usage of electronic gift certificates. The system comprises a gift certificate service server for managing purchase, gifting, and usage operations on the electronic gift certificates from the communication terminal; a gift certificate database, accessed by the gift certificate service server, for storing electronic gift certificate information, and processing a reply to an inquiry of electronic gift certificate usage from the gift certificate service server; and a network server, accessed by the gift certificate service server and accessed by the user's communication terminal through the wired network, wireless network, or both, for performing a client interface function of the purchase, gifting, and usage of the electronic gift certificates.

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By contrast, the Messner '514 patent discloses a method for marketing and redeeming vouchers for use in online purchases that includes a voucher server for processing the related transactions. In this regard, the voucher server maintains a database of participating merchants, virtual malls, and outstanding purchased vouchers. As such, a user may purchase a voucher and the voucher may be delivered to a recipient. Upon proper delivery to the recipient, the voucher is stored in the database. In this regard, Applicant initially notes that the Messner '514 patent fails to teach or suggest a gift certificate database as recited in independent Claim 1. Indeed, the Messner '514 patent discloses that the purchased voucher is stored in the voucher server. As such, the database storing the voucher is in the voucher server and accordingly, the voucher server and the database are one entity. By contrast, independent Claim 1 recites a gift certificate service server and a gift certificate database, separate from the gift certificate server, for storing electronic gift certificate information. In this regard, the gift certificate information is not stored in the gift certificate service server. Additionally, as mentioned above, the Messner '514 patent discloses that the purchased voucher is only stored in the voucher server if the voucher has been properly delivered to the recipient. As such, only a limited number of purchased vouchers is stored. By contrast, independent Claim 1 recites that the gift certificate information is stored in the gift certificate database, regardless of whether the gift certificate has been delivered or not.

Additionally, the Official Action acknowledges that the Messner '514 patent fails to disclose a distinct network server accessed by the gift certificate service server and accessed by the user's communication terminal through a network, as recited in independent Claim 1. Moreover, the Official Action acknowledges that the Messner '514 patent fails to disclose a network server for performing a client interface function of the purchase, gifting, and usage of the electronic gift certificates and transmitting the user's gift certificate purchase particulars and gift certificate information for usage of the corresponding gift certificate to the communication terminal, as recited in independent Claim 1. However, the Official Action indicates that "it is well known to transmit information on purchase particulars to users' computers or other communication terminals to perform client interface functions." Nonetheless, Applicant respectfully submits that transmitting information on purchase particulars to users' computers or

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other communication terminals to perform client interface functions in the context of an electronic gift certificate, as recited in the claimed invention, was not necessarily well known at the time of Applicant's invention, as evidenced by the lack of disclosure of such application in the Messner '514 patent. In this regard, Applicant respectfully submits that the Official Action is relying on improper hindsight. As such, to the extent that the Official Action is taking Official Notice of this feature of the claimed invention, Applicant seasonably challenges the manner in which Official Notice is taken and asks that the Office produce a document substantiating the allegation set forth by the Official Action in conjunction with this feature of the claimed invention, if the rejection is to be maintained in a subsequent Official Action, as these conclusions are not "instant and unquestionable" as being well known at the time of the invention (MPEP §2144.03) ("Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.").

Therefore, the Messner '514 patent, taken either individually or even in combination with the Official Notice, fails to teach or suggest each and every element of independent Claim 1 for at the least the reasons discussed above. Accordingly, Applicants submit that the rejection of Claim 1 and the claims dependent therefrom, namely Claims 1-4, over the Messner '514 patent, taken individually or in combination with the Official Notice, is overcome.

Applicant notes the comments on page 10 of the Official Action regarding the "means for" language of Claims 2-4. In this regard, Applicant respectfully submits that Claims 2-4 should be treated as invoking 35 U.S.C. § 112, sixth paragraph.

Applicant also notes that independent Claims 5, 10 and 15 recite features similar to independent Claim 1, such as, for example, the gift certificate database discussed above. As previously mentioned, the Messner '514 patent fails to teach or suggest a gift certificate database as recited in the claimed invention. Therefore, the Messner '514 patent, taken either individually

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or even in combination with the Official Notice, also fails to teach or suggest each and every element of independent Claims 5, 10 and 15 for at least the reasons discussed above with respect to independent Claim 1. Accordingly, the rejection of independent Claims 5, 10 and 15 and the claims respectively dependent therefrom, namely Claims 6-9, 11-14 and 16-23, over the Messner '514 patent, taken individually or in combination with the Official Notice, is also overcome.

Additionally, with respect to dependent Claims 2-4 and independent Claims 10 and 15, Applicant initially notes that the claims are not taught or suggested by the Messner '514 patent, either individually or in combination with the Official Notice, for at least the reasons discussed above with respect to independent Claim 1, for, respectively, their dependency from independent Claim 1 and their recitation of features similar to independent Claim 1. Moreover, the Messner '514 patent fails to teach or suggest notifying the user of the gift certificate purchase particulars and information in a message format. However, the Official Action indicates that "it is well known to notify users of purchase particulars" and further indicates that "it is well known to notify users of relevant information." Nonetheless, Applicant respectfully submits that notifying users of purchase particulars and other information in the context of an electronic gift certificate, as recited in the claimed invention was not necessarily well known at the time of Applicant's invention, as evidenced by the lack of disclosure of such application in the Messner '514 patent. In this regard, Applicant respectfully submits that the Official Action is relying on improper hindsight. As such, to the extent that the Official Action is taking Official Notice of this feature of the claimed invention, Applicant seasonably challenges the manner in which Official Notice is taken and asks that the Office produce a document substantiating the allegation set forth by the Official Action in conjunction with this feature of the claimed invention, if the rejection is to be maintained in a subsequent Official Action, as these conclusions are not "instant and unquestionable" as being well known at the time of the invention (MPEP §2144.03) ("Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.").

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Moreover, with respect to dependent Claims 2 and 5, the Messner '514 patent fails to teach or suggest checking a settlement state of the electronic gift certificate. However, the Official Action indicates that "it is well known to check the settlement state of a purchase." Nonetheless, Applicant respectfully submits that checking a settlement state of a purchase in the context of electronic gift certificates in a unified electronic gift certificate system, as recited in the claimed invention, was not necessarily well known at the time of Applicant's invention, as evidenced by the lack of disclosure of such application in the Messner '514 patent. Indeed, the present application discloses that such a unified system prevents additional settlement processes when a user utilizes electronic gift certificates. See, for example, paragraph [0014] of Applicant's disclosure. In this regard, Applicant respectfully submits that the Official Action is relying on improper hindsight. As such, to the extent that the Official Action is taking Official Notice of this feature of the claimed invention, Applicant seasonably challenges the manner in which Official Notice is taken and asks that the Office produce a document substantiating the allegation set forth by the Official Action in conjunction with this feature of the claimed invention, if the rejection is to be maintained in a subsequent Official Action, as these conclusions are not "instant and unquestionable" as being well known at the time of the invention (MPEP §2144.03) ("Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.").

Additionally, with respect to Claims 9, 14 and 17, Applicant initially notes that because the Messner '514 patent fails to teach or suggest each and every element of the independent Claims 10 and 15, Claims 9, 14 and 17 are also not taught or suggested by the Messner '514 patent, either individually or in combination with the Official Notice, because of their dependency from their respective independent claims as discussed above. Moreover, the Messner '514 patent fails to teach or suggest that the message format received by the user includes the SMS or MMS formats. However, the Official Action indicates that "the SMS and MMS formats are well known". Nonetheless, Applicant respectfully submits that notifying users

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in a message format that includes SMS or MMS formats in the context of electronic gift certificates, as recited in the claimed invention was not necessarily well known at the time of Applicant's invention, as evidenced by the lack of disclosure of such application in the Messner '514 patent. In this regard, Applicant respectfully submits that the Official Action is relying on improper hindsight. As such, to the extent that the Official Action is taking Official Notice of this feature of the claimed invention, Applicant seasonably challenges the manner in which Official Notice is taken and asks that the Office produce a document substantiating the allegation set forth by the Official Action in conjunction with this feature of the claimed invention, if the rejection is to be maintained in a subsequent Official Action, as these conclusions are not "instant and unquestionable" as being well known at the time of the invention (MPEP §2144.03) ("Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.").

Moreover, with respect to dependent Claims 3 and 10, the Messner '514 patent fails to teach or suggest inquiring as to an existence state of the gift certificate possessed by the user of the gift certificate database and determining the existence state. However, the Official Action indicates that "it is well known to determine the existence and/or validity of files, etc., to be transferred." Nonetheless, Applicant respectfully submits checking the existence state of gift certificates possessed by users of a gift certificate database and determining the existence state in the context of electronic gift certificates in a unified electronic gift certificate system, as recited in the claimed invention, was not necessarily well known at the time of Applicant's invention, as evidenced by the lack of disclosure of such application in the Messner '514 patent. In this regard, Applicant respectfully submits that the Official Action is relying on improper hindsight. As such, to the extent that the Official Action is taking Official Notice of this feature of the claimed invention, Applicant seasonably challenges the manner in which Official Notice is taken and asks that the Office produce a document substantiating the allegation set forth by the Official Action in conjunction with this feature of the claimed invention, if the rejection is to be maintained in a subsequent Official Action, as these conclusions are not "instant and

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unquestionable" as being well known at the time of the invention (MPEP §2144.03) ("Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.").

For at least the foregoing reasons, Applicants respectfully submit that the rejection of Claims 1-23 under 35 U.S.C. § 103(a) is overcome.

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CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the claims of the present application are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicant's undersigned attorney to resolve any remaining issues in order to expedite examination of present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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